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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,393	07/18/2003	Kevin Conwell	13551	4619

7590 08/17/2005
ORUM & ROTH
53 W. JACKSON BLVD
CHICAGO, IL 60604

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,393

Applicant(s)

CONWELL ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 10-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8 and 10-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Rejections withdrawn

1. Claims 8 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Koops (5824397) made in the last Office Action has been withdrawn in view of the amendment filed on June 14, 2005.
2. Claim 15 rejected under 35 USC 112, second paragraph has been withdrawn in view of the amendment.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 4-8, 10-20 and newly submitted claims 21-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-8, 9-15 and new claim 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koops in view of Majumdar (6221453).

Koops relates to a tire label comprising a label facestock (2) coated on a first side with pressure sensitive rubber based adhesive (4). See abstract and col. 3, lines 8-10. The

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facestock can be EPDM rubber (col. 3, lines 34-35) has a thickness of 10-2500 microns (col. 3, lines 58-60) which includes the claimed range of 0.001 to 0.008 inches. EPDM is well known as a polyolefin and the instant specification, in page-7, lines 34-35, recites that one of the polyolefins is EPDM. The label includes a barrier coating (3) between the facestock and the adhesive. The barrier material can be inter alia, polyamide or metal layer (col. 5, lines 26-33) having a thickness of 1 to 20 microns. The adhesive temporarily fixes to rubber parts (col. 7, lines 1-4). The barrier coating inhibits migration of mobile substances from an object and/or from the adhesive (col. 3, lines 19-30), substances such as plasticizers. The label can be provided with inscription such as bar codes or text print (col. 6, lines 41-42). However, Koops fails to teach that the barrier coating is a polyester film, including polyethylene terephthalate (PET). Majumdar discloses a harmonic label for marking tires which includes a barrier layer to prevent migration of staining components. The barrier material can be metal, polyester, etc. (col. 3, lines 40-44). Thus, Majumdar shows that polyester and metal are equivalent barrier material known in the art. Therefore, because these two polyester and metal were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute polyester for metal.

Also, the adhesive layer of Koops having a thickness of 0.001 to 0.004 inches would have been obvious, based on optimization through routine experimentation, to provide optimum adhesion of the label to a substrate.

Also, because the facestock material is the same as the claimed material, it would exhibit the claimed stiffness of 20-80 mg for enhancing conformability.

5. Claims 15-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koops in view of Majumdar and further in view of Voeller (6822582).

Koops and Majumdar, as discussed above, fails to teach the presence of RFID tag on the base substrate. Voeller relates to RFID tag for a tire (abstract), and that presence of alpha-numeric or bar code marking and RFID tag (col. 2, lines 8-12) are found to be functional equivalent. Therefore, because these two RFID tags and alpha-numeric/bar code marking were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute RFID tags for alpha-numeric/bar code markings.

Response to Arguments

6. Applicant's arguments filed June 14, 2005 have been fully considered but they are not persuasive.

Applicant argues that Koops does not teach or suggest a label with a face stock of a conformable polyolefin or polypropylene film and a barrier coating of polyester film. This is not deemed to be convincing, Koops, in col. 3, lines 34-35 recites face stock material which includes EPDM, which is a polyolefin as per the instant application specification, page-7, lines 34-35. For the presence of a polyester barrier layer, applicant is reminded that said barrier material is disclosed in Majumdar. Further, as mentioned in the rejection under 35 USC 103(a) above, Majumdar clearly teaches that use of polyester or metal as barrier material were art recognized equivalents at the time the invention was

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made. The Majumdar reference was cited to show the use of the barrier materials as functionally equivalent and applicant has failed to provide any showing that the two barrier materials were not functionally equivalent.

Applicant also argues that the Voeller (US Patent 6822582) is not a prior art because the instant application is a C-I-P of application serial No. 10/391036 filed on March 18, 2003 and it claims benefit of US provisional applications 60/379965 and 60/397207 filed on May 10, 2002 and July 19, 2002, respectively. This is not found to be persuasive because no support for the claimed barrier material of polyester nor the presence of RFID could be located in the parent application 10/391036. Therefore, in the absence of any showing otherwise, the Voeller reference is a proper prior art.

Thus, in the absence of any showing to the contrary, it remains the examiner's position that the claimed invention would have obvious over the prior art of record discussed above.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772
8/14/05

N. Ahmad.
August 14, 2005.